

REMARKS

In the Advisory Action mailed May 2, 2006 ("Advisory Action"), the Examiner stated that the Applicants' proposed amendments and new claims would not be entered asserting that such raised new issues requiring a new search. In response, the Applicants are filing the RCE so that the claim amendments and new claims are entered and all claims are considered. For the reasons set forth below, the Applicants respectfully request that the Examiner allow all the claims.

Rejections Under 35 U.S.C. 112

Claims 6 and 10 are rejected under 35 U.S.C. § 112 ¶ 2 for insufficient antecedent basis for the claim term "prior to a transmission of the email message" present in element (c) of claims 6 and 10.

Applicants respectfully disagree with the rejection but assert that the rejection is moot in light of the amendments to claims 6 and 10. Support for element (c) of claims 6 and 10 as amended is provided in Applicants' specification at, for example, page 5, lns. 15-18. It is respectfully submitted that claims 6 and 10, as amended, comply with the requirements of 35 U.S.C. § 112 ¶ 2.

Rejections Under 35 U.S.C. 103

a. Claims 6-9

Claims 6-9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,775,359 to Ron et al. ("*Ron*") in view of U.S. Patent No. 6,463,134 to Okada ("*Okada*").

To establish a prima facie case of obviousness, three basic criteria must be met. See MPEP §§ 706.02(j), 2143-2143.03; *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *Id.*

With respect to claim 6, the Applicants submit that *Ron* and *Okada* do not disclose or suggest the combination set forth in claim 6, which includes, *inter alia*, "determining if the user of the

portable electronic device is registered as a user of the email server”, and “obtaining a pre-assigned message-identifying indicium from the user of the portable electronic device, the message-identifying indicium having been assigned to an email message received by the user of the portable electronic device prior to receipt of the email message by that user.” With respect to the “determining” element, on pages 4-5 of the Final Office Action mailed January 23, 2006 (“Final Office Action”), the Examiner concedes that *Ron* does not disclose or suggest this element, however, the Examiner asserts that *Okada* at col. 13, lns. 1-8 discloses this element. This portion of *Okada* merely discloses determining the “reply destination” of the “personal computer 10” (i.e., it does not disclose determining anything for the “portable telephone 30”), rather than “determining if the user of the portable electronic device is registered as a user of the email server” as recited in claim 6. With respect to the “obtaining” element, on pages 4-5 of the Final Office Action, the Examiner concedes that *Ron* does not disclose or suggest this element, however, the Examiner asserts that *Okada* at col. 13, lns. 21-39 discloses this element. This portion of *Okada* discloses obtaining the “mail ID” from the “electronic mail management section 22” of the “gateway unit 20”, rather than from “the user of the portable electronic device” as recited in claim 6.

In the Advisory Action, the Examiner seems to request clarification of the term “portable electronic device”. The specification describes a “portable electronic device” as a portable device such as, e.g., “cell phone 22”, “palmtop computer (PDA) 24”, and “pager 26” shown in FIG. 1. (pg. 4, lns. 22-23). In the Advisory Action, the Examiner states that “in figure 2 Ron shows a portable device.” The “cellular phone 103” of figure 2 is an example of a “portable electronic device”, however, *Ron* does not disclose or suggest “determining if the user of the portable electronic device is registered as a user of the email server” as recited in claim 6. In fact, on pages 4-5 of the Final Office Action, the Examiner concedes that *Ron* does not disclose or suggest “determining if the user of the portable electronic device is registered as a user of the email server” as recited in claim 6.

In addition, the Applicants submit that the Examiner has not established a prima facie case of obviousness since the Examiner has not provided an adequate suggestion to combine *Ron* and *Okada*. The Examiner has the burden of showing that the cited references provide a suggestion to combine them. *See, e.g.*, MPEP 2142. *Okada* teaches that the “portable telephone 30” obtains the “mail ID” from the “electronic mail management section 22” of the “gateway unit 20”. In *Ron*, the “cellular phone 103” cannot obtain such a “mail ID” since *Ron* teaches that the output of the

“cellular phone 103” is sent to the “voicemail system 201”, however, the “voicemail system 201” cannot provide a “mail ID”. Because the combination of *Ron* and *Okada* results in a device that is unsatisfactory for its intended purpose, there is no motivation to combine these two references and thus the Examiner has not established a prima facie case of obviousness. *See, e.g.*, MPEP 2143.01.

For at least the foregoing reasons, the Applicants respectfully request reconsideration and allowance of claim 6. Claims 7-9 depend from claim 6. Accordingly, they are also patentable over the cited prior art references for at least the reasons provided earlier with respect to claim 6.

b. Claim 10

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,442,242 to McAllister et al. (“*McAllister*”) in view of *Ron* and further in view of *Okada*.

The Applicants submit that *McAllister*, *Ron*, and *Okada* do not disclose or suggest the combination set forth in claim 10, which includes, *inter alia*, “determining if the user of the portable electronic device is registered as a user of the email server”, and “obtaining a pre-assigned message-identifying indicium from the user of the portable electronic device, the message-identifying indicium having been assigned to an email message received by the user of the portable electronic device prior to receipt of the email message by that user.” For the reasons provided earlier with respect to claim 6, *Ron* and *Okada*, either singly or together, do not disclose or suggest these two elements. *McAllister* does not cure these deficiencies. *McAllister* discloses a call processing apparatus where the caller provides information needed to process a request (e.g., a request to ship a new battery) but if the request requires other processing, then a voice message pertaining to the other processing is recorded and attached to an e-mail message associated with the request and these are transmitted to the appropriate department. (col. 8, lns. 11-38). *McAllister*, however, does not disclose or suggest, *inter alia*, the “determining” or the “obtaining” elements recited in claim 10. Thus, claim 10 is patentable over the cited prior art references, and therefore the Applicants respectfully request allowance of claim 10.

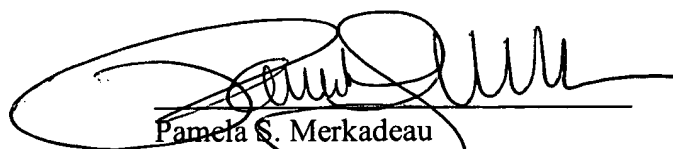
New Claims

New claims 11-13 depend from independent claim 6, and new claims 14-16 depend from independent claim 10. Thus, these new claims are patentable over the cited prior art references at least for the reasons provided earlier with respect to claims 6 and 10. In addition, new claims 13 and 15 are patentable over the cited prior art references because these references fail to disclose or suggest, *inter alia*, that the "pre-assigned message-identifying indicium allows the voice message to be transmitted efficiently to the office-based terminal" as set forth in those two claims. Support for claims 11-12 and 14-15 is provided in Applicants' specification at, e.g., pg. 7, lns. 2-13. Support for claims 13 and 16 is provided in Applicants' specification at, e.g., pg. 5, lns. 15-18. The Applicants respectfully request that the new claims be allowed.

CONCLUSION

On the basis of the above remarks, reconsideration and allowance of all the pending claims is believed to be warranted and such action is respectfully requested. If the Examiner has questions or comments, the Examiner is respectfully requested to contact the undersigned at the number listed below. The Office is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1847.

Respectfully submitted,



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